



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,398	09/23/2003	Marie-Christine Piedboeuf	86331-11	9362

28291 7590 02/09/2006

FETHERSTONHAUGH - SMART & BIGGAR
1000 DE LA GAUCHETIERE WEST
SUITE 3300
MONTREAL, QC H3B 4W5
CANADA

EXAMINER

EASHOO, MARK

ART UNIT	PAPER NUMBER
----------	--------------

1732

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,398

Applicant(s)

PIEDBOEUF, MARIE-CHRISTINE

Examiner

Mark Eashoo, Ph.D.

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 18-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2 ea.</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1732

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-17, in the reply filed on 14-NOV-2005 is acknowledged. The traversal is on the ground(s) that essentially there is no burden on the Office to examine all claim groupings. This is not found persuasive because the search and consideration of a process is does not require the specifics required for an apparatus. For example, apparatus structure in a process claim does not require the claimed structure of the apparatus but only requires consideration to the extent that the equivalent function of the apparatus would be achieved in the process.

The requirement is still deemed proper and is therefore made FINAL.

Claim 18-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claim grouping, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 14-NOV-2005.

Claim Rejections - 35 USC § 112 & 101

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 provides for the use of a method of making a sheet material, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 17 provides for the use of a method of making a sheet material, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Art Unit: 1732

Claim 17 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Horner (US Pat. 4,093,188).

Regarding claim 1: Horner teaches the claimed process of creating color effects in an extrudable material, comprising: providing a first flow of viscous material having a first color (8:50-9:10); providing a second flow of viscous material having a second color different from the first color (8:50-9:10); combining first and second flows in an adjacent manner to form a stream (8:50-9:10); and feeding the stream through a static mixer to form a third color (8:50-9:10).

Regarding claims 2-4, 9-11: Horner teaches a gradation of color, or a varying mixture (eg. pink), between many/multiple red and white areas (8:50-9:10). As such it is inherent that the gradation of color occurs between the two colors.

Regarding claims 5-7: The examiner recognizes that all of the claimed effects and physical properties are not positively stated by the reference(s). However, the reference(s) teaches all of the claimed ingredients, process steps, and process conditions. Therefore, the claimed effects (ie. horizontal layers, vertical layers or concentric layers) and physical properties would *inherently* be achieved by carrying out the disclosed process. If it is applicants' position that this would not be the case: (1) evidence would need to be presented to support applicants' position; and (2) it would be the examiner's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects by carrying out only these process steps.

Regarding claim 8: Horner teaches a helical /spiral mixer (8:50-9:10 and 1:60-2:7).

Regarding claim 14: Horner teaches polymeric/plastic fluids (1:34-51).

Claims 1, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bambara et al. (US Pat. 5,998,006).

Regarding claim 1: Bambara et al. teaches the claimed process of creating color effects in an extrudable material, comprising: providing a first flow of viscous material having a first color (1:24-55, 3:5-30 and Fig. 1); providing a second flow of viscous material having a second color different from the first color (1:24-55, 3:5-30 and Fig. 1); combining first and second flows in an adjacent manner to form a stream (Fig. 1, elements 20, 24); and feeding the stream through a static mixer (ie. a breaker plate) to form a third color (Fig. 1, elements 18 and 4; see also Fig. 4). It is inherent that the colorants are blended to some degree to form a color between the base color and the colorant (or mixtures of

Art Unit: 1732

colorants and a base color) since, Bambara et al. teaches that the colorants are not thoroughly mixed to form a homogeneous mixture (9:35-45).

Regarding claim 12: Bambara et al. teaches forming a sheet (3:25-30 and Fig. 4).

Regarding claim 13: Bambara et al. teaches forming a tube or an annular profile (3:25-30).

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Bambara et al. (US Pat. 5,998,006).

Regarding claim 15: Bambara et al. teaches the claimed process of creating color effects in an extrudable material, comprising: providing a first flow of viscous material having a first color (1:24-55, 3:5-30 and Fig. 1); providing a second flow of viscous material having a second color different from the first color (1:24-55, 3:5-30 and Fig. 1); combining first and second flows in an adjacent manner to form a stream (Fig. 1, elements 20, 24); and feeding the stream through a static mixer (ie. a breaker plate) to form a third color (Fig. 1, elements 18 and 4; see also Fig. 4).

It is inherent that the colorants are blended to some degree to form a color between the base color and the colorant (or mixtures of colorants and a base color) since, Bambara et al. teaches that the colorants are not thoroughly mixed to form a homogeneous mixture (9:35-45). Also, it is noted that Fig. 4 shows a sheet of material that substantially has a gradation of colors.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached form PTO-892.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (571) 272-1197. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Eashoo, Ph.D.
Primary Examiner
Art Unit 1732

me
February 6, 2006

06/Feb/06